

REMARKS

Applicant thanks the Examiner for taking the time to discuss the present application with Applicant's attorney, David Loretto.

Applicant acknowledges the objection to the drawings and will submit formal drawings upon allowance of the claims. Further, if deemed necessary by the Examiner, Applicant will submit a Petition to Correct the Filing Receipt and amend the specification to reflect the priority claim to Provisional Appl'n Ser. No. 60/138,843 filed on June 10, 1999.

Claims 1-8 and 12-22 stand rejected under section 102(e) as either being anticipated or rendered obvious by U.S. Published Patent Application No. 2003/0078763 A1, to Chuang et al. ("Chuang") in combination with the work Kenneth Shepard, the inventor of the present application.

Claims 9-11 stand merely objected to and would be deemed allowable if rewritten in independent form.

By this amendment, Applicant has canceled claims 1-8 and 12-22 and amended claim 9 to incorporate the limitations of canceled claims 1, 2, and 6.

In the June 15, 2005 Office Communication, the Examiner cited (1) Applicant's expression of grateful acknowledgement to Mr. C. T. Chuang and others for "encouragement, helpful discussions and preprints of their work" in the final paragraph of a paper published in the ICCAD '99 proceedings by Applicant and his then graduate student (Ex. A to Applicant's June 28, 2004 Response), (2) Mr. C. T. Chuang's co-authorship of references [1], [2], [4], [5], and [6] of the same ICCAD '99 paper, and (3) Mr. C. T. Chuang's co-authorship of the alleged 102(e) prior art used by the Examiner to

reject claims 1-8 and 12-22. On this basis, the Examiner requested that Applicant “clarify Mr. Chuang’s role in the claimed invention.” (Office Communication at page 4.)

In subsequent telephone conversations with Applicant’s attorney, David Loretto, the Examiner explained that this clarification by Applicant could be in the form of a “Katz” declaration. *See In re Katz*, 687 F.2d 450 (C.C.P.A. 1982) (finding that a declaration under 37 C.F.R. § 1.132 was sufficient evidence to establish that the subject disclosure was declarant’s own work).

Accordingly, Applicant submits herewith a Declaration of Kenneth L. Shepard Submitted Pursuant to Section 1.132 in which Dr. Shepard explains that Mr. C. T. Chuang had *no role* in the inventions recited in the claims of the present application. In particular, Dr. Shepard explains that his acknowledgement of Mr. C. T. Chuang in the final paragraph of the ICCAD ’99 publication reflected nothing more than the professional courtesy customarily extended to a fellow researcher and former colleague in a highly specialized technical field. Dr. Shepard further explains that the reference in his ICCAD ’99 publication to papers co-authored by Mr. C.T. Chuang was merely a recognition of having worked together for several years in the same general field as Mr. C. T. Chuang.¹

¹ In any event, Applicant respectfully notes that it is a J. Chung, and not C. T. Chuang, who is listed as a co-author of reference [4] in the ICCAD ’99 paper.

CONCLUSION

In view of the above, Applicant respectfully submits that the pending claims are in condition for allowance and solicits such action. In the event that any additional information is required, the Examiner is requested to contact Applicant's attorneys on the number given below.

Respectfully submitted,



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Enclosure